

Appl. No. : 10/673,036
Filed : September 25, 2003

REMARKS

The Examiner mailed a Notice of Non-Compliant Amendment (37 C.F.R. § 1.121) on September 6, 2005. According to the Notice, the *Amendment and Response to Office Action* filed on August 30, 2005 was non-compliant because it included two claims numbered as claim number "22." Applicants corrected that error and made the necessary corrections to the dependent claims. In view of the correction, Applicants respectfully request entry of the above-listed claims. Applicants respond below to the rejections made in the Office Action mailed on May 31, 2005.

Applicants have herein cancelled Claims 1-9 and 17 without prejudice to pursuing the claims in a divisional, continuation, or continuation-in-part application. Claims 10-12 are amended as set forth above. Also, entry of new Claims 18-28 is respectfully requested. Support for the amendments and the new claims may be found in the original claims as filed and in paragraphs [0009] and [0010] of the specification, for example. No new matter is added by the amendments or by the addition of the new claims.

In view of the amendments discussed above, Claims 10-16 and 18-28 remain pending. Applicants have carefully considered all of the Examiner's rejections and respectfully submit that the pending claims are allowable for at least the following reasons.

Discussion of Rejections under 35 U.S.C. § 112, second paragraph

The Examiner has rejected Claims 1-17 under 35 U.S.C. § 112, second paragraph, as being indefinite. As set forth above, Claims 10-16 and 18-28 are pending. Therefore, Applicants address the indefiniteness rejections pertaining to those claims. The Examiner has asserted that Claim 1 was written in improper Markush language it does not refer to "acid addition salts" and "prodrug esters" in the alternative. Further, the Examiner has asserted that the nature of the "prodrug esters" is not known.

Claim 10 has been amended to recite in an alternative form "its acid-addition salts or its pro-drug esters" (underlined text added for emphasis). Thus, Applicants submit that Claim 10 is definite insofar as it refers to these elements in the alternative.

Also, Applicants respectfully submit that the term "prodrug esters" is not indefinite. For example, the specification at paragraph [0026] describes and explains prodrug esters, and describes specific exemplary prodrug esters. Therefore, Applicants respectfully submit that the term "prodrug esters" is clear and definite in view of the teachings in the specification.

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Also, the Examiner has asserted that the differences in scope of, *inter alia*, Claims 11 and 12 is not understood. The claims recite different aspects of the invention. For example, Claim 11 recites a step of "administering," while Claim 12 recites a step of "contacting."

In view of the above, reconsideration and withdrawal of the rejections under § 112, second paragraph, is respectfully requested.

Discussion of Rejections under 35 U.S.C. § 112, first paragraph

The Examiner has rejected Claims 1-17 under 35 U.S.C. § 112, first paragraph, for lacking enablement. Applicants note, however, that the Examiner expressly acknowledged, on page 5 of the Action, "[t]he claims are enabled for the compound of claim 10 and the use of the same to treat colon cancer, prostate cancer, leukemia and melanoma." Accordingly, as set forth above, Applicants have canceled compound Claims 1-9 and method Claim 17. Furthermore, method Claims 11 and 12 have been amended recite specified uses of the compound of Claim 10. Therefore, Applicants respectfully request withdrawal of the instant enablement rejection because, as the Examiner has acknowledged, the pending claims are enabled.

CONCLUSION

By the foregoing amendments and remarks, the Applicants respectfully submit that they have overcome the Examiner's rejections and request a timely issuance of a Notice of Allowance.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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